

REMARKSRequest for Personal Interview

Applicant respectfully requests an in-person interview to discuss the present claims in view of the previously cited art. The Examiner is respectfully invited to contact the undersigned (503-495-4575) should the Examiner pick up this Amendment prior to the scheduling of an interview.

Claim Status

Claims 1-16, 21 and 22 remain pending in the present application. Claims 4, 9 and 13 have been amended in an editorial manner and without prejudice.

Art-Base Rejections

Claims 4-6 were previously rejected as being anticipated by Lubawy (US Patent No. 6,353,479). Claims 1-3 and 15 were previously rejected under Lubawy in view of Rhoads (US Patent No. 5,850,481). Claims 7, 10-13 and 16 were previously rejected over Lubawy in view of Ta (US Patent No. 5,500,715). Claims 21 and 22 were previously rejected over Lubawy and Ta in further view of Brenner (US Patent No. 6,318,827). Claims 8 and 9 were previously rejected over Lubawy and Ta, and in further view of Kim (US Patent No. 6,276,771).

Applicant respectfully disagrees with these previous rejections.

Claim 4 in view of Lubawy

Claim 4 recites a steganographic message that is encoded in the form of a digital watermark, in combination with other features of the claim. The Office suggests that a barcode meets the digital watermark features of the claims. Applicant respectfully disagrees. Lubawy at Col. 2, lines 3-5 teaches that the fluorescent bar code become visible with ultraviolet radiation. At such a point of illumination, a human viewer is able to perceive that the media is marked with a message or code. In contrast, even if subtle variations associated with a digital watermark are perceived, a human viewer would not necessarily interpret the variations as a marking, as they would a barcode. Thus,

Lubawy's barcode does not teach a digital watermark that does not betray the existence of a steganographic message, in combination with the features of claim 4.

Claim 4 should be allowed.

Claim 7 in view of Lubawy and Ta

The Office correctly determined that Lubawy fails to teach or suggest at least optimizing printing resolution *to accommodate* physical characteristics of the print media, e.g., in combination with the features of claim 7. To remedy this, the office cites Ta.

Applicant objects to the proposed combination of Lubawy and Ta. The Office fails to establish proper motivation for such a combination, or even hint at successfully combining as proposed. Such a combination is considered improper.

Nevertheless, even if combined as suggested, the combination fails to teach optimization to accommodate physical characteristics of print media, in combination with the remaining features of the claim.

To illustrate, Ta at Col. 7, lines 52-55, allows for a section of print resolutions, but fails to tie the resolution to accommodate physical characteristics of print media.

Note also the apparent contradiction in the Office Action. The Office rejects claim 7 over Lubawy and Ta, but then states that the proposed combination is deficient in its analysis of claims 21 and 22 on page 8, paragraph 9. ("Ta teaches that the printer processor will automatically determine the if [sic] printer setup menu selections have been set, *but that does not specifically teach optimizing resolution based on print media and neither does Lubawy.*" (emphasis added))

Claim 7 should be allowed over the proposed combination.

Claim 16 in view of Lubawy and Ta

The proposed combination fails to teach or suggest steganographically decoding a message from the image, *the message including printer control information related to an optimal resolution for printing on the print media with respect to at least a physical characteristic of the print media*, in combination with the remaining features of the claim.

The discussion of selection of print resolution of Ta does not provide a nexus to the physical characteristics of the print media.

Note again the apparent contradiction in the Office Action. The Office rejects claim 16 over Lubawy and Ta, but then states that the proposed combination is deficient in its analysis of claims 21 and 22 on page 8, paragraph 9. ("Ta teaches that the printer processor will automatically determine the if [sic] printer setup menu selections have been set, *but that does not specifically teach optimizing resolution based on print media and neither does Lubawy.*" (emphasis added))

Claim 16 should be allowed.

Claims 21 and 22

Applicant objects to the proposed combination of Labawy and Ta and now Brenner. The proposed motivation, as stated on page 8, paragraph 9, of the office action fails to suggest a combination for optimal print resolution including both print resolution and control information carried by a steganographic message on print media.

Moreover, even if combined as suggested, there is an insufficient nexus between Benner's rendering resolution and Ta and Labawy to even achieve and the claimed combination.

Claims 21 and 22 should be allowed.

Claim 15 in view of Lubawy

The Office Action merely mentions in a parenthetical (see the Office Action on page 5) the term "absorbance." The Office failed to address how (and where) Labawy teaches the proposed combination as recited in claim 15.

Clarification is requested.

Claim 13 in view of Lubawy and Ta

Claim 13 has been amended to point out particulars of one of the many types of digital watermarking (e.g., spread-spectrum modulation). Support for this clarification can be found, e.g., on page 4, lines 1-2. (The patent documents mentioned therein are incorporated by reference on page 7, lines 9-11, of the specification.) The proposed

combination of documents is not understood to teach or suggest a method for adapting operation of a printer to a type of print media including: i) providing a digitally watermarked sheet of print media to the printer, wherein a digital watermark in the digitally watermarked sheet of print media includes an identifier, *wherein the identifier comprises at least some spread spectrum modulated binary bits*; ii) capturing an image of at least a portion of the print media; iii) decoding the identifier from the image, wherein the identifier includes printer control information; and iv) using the printer control information to index corresponding printer operating parameters which relate to physical characteristics of the print media and adapting operation of the printer in accordance with the parameters.

Claim 13 should be allowed.

Claim 1 in view of Lubawy and Rhoads

Lubawy discusses a “fluorescent bar code” or infrared fluorescent markings provided through ink or fluid. Lubawy does not even hint at encoding through modulation of surface microtopolgy, nor does it suggest reading structure to accomplish such. The Office attempts to combine with one of assignee’s Rhoads’ patents, without a sufficient statement of motivation for doing so. Thus, the proposed combination is considered improper.

Reconsideration is requested.

Dependent Claims

The many dependent claims currently pending in this application also recite additional patentable features in combination with their respective base claims.

Favorable and independent consideration is requested.

Information Disclosure Statement

An Information Disclosure Statement and Form 1449 are submitted concurrently herewith. Consideration of these documents is respectfully requested.

Conclusion

Withdrawal of the above-noted rejections and early passage to issuance are respectfully requested. (Applicant does not belabor other shortcomings of the art herein.).

We look forward to our upcoming interview. In the meantime, the Examiner is invited to telephone the undersigned at 503-495-4575 with any questions.

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Respectfully submitted,

Customer No. 23735

DIGIMARC CORPORATION

Phone: 503-885-9699

FAX: 503-885-9880

By 

Steven W. Stewart
Registration No. 45,133